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09/822,651	03/30/2001	Scott J. Tuman	54407US006	9447

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EXAMINER	
LIGHTFOOT, ELENA TSOY	
ART UNIT	PAPER NUMBER
1792	

NOTIFICATION DATE	DELIVERY MODE
10/03/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	09/822,651	TUMAN ET AL.	
	Examiner	Art Unit	
	Elena Tsoy Lightfoot	1792	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 August 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *71-79,81-83,85-90 and 92-115* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *71-79,81-83,85-90 and 92-115* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Withdrawal of Finality

Prosecution on the merits of this application is reopened by the Decision of Pre-Appeal Conference on September 11, 2008. The conferees Gregory Mills and Timothy Meeks made a decision to withdraw the finality of the last Office Action as not addressing "new matter" added to original claims, and enablement issues.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 71-79, 81-83, 85-90, and 92-115 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitation "the polymer forming the polymeric regions does not extend *through* the substrate" (independent claims 71, 83, 94, 109-115) wherein the substrate containing ***loop*** structures (claims 73, 87, 97, 111, 113-115) is a **fibrous** (Claims 75, 88, 94, 111, 113-115) or a **porous** material (Claims 76, 89, 99) of e.g. **non-woven** material (Claims 78, 101) or **elastic** web (Claims 72, 83, 96, 110) such as a **woven** web (Claims 77, 100) and a **knit** web (Claims 79, 102), was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Applicants' specification

discloses that the source 53 deposits the **melted** polymeric material on the web 50 as discrete portions 55; the portions 55 are simultaneously *pressed* into the cavities and fused to the web 50, and a casting roll 58 provides **pressure** against the back side of the web 50 as the polymeric material cools, thereby assisting in **pressing** the polymeric material into the cavities in tooled surface 57 of tool roll 56 and fusing of the polymeric material to the web 50 (See Fig. 5 and page 8 , lines 4-7). However, the Applicants' specification discloses ***nowhere*** that the melted polymer does not go *through* the **porous** material, **fibrous** material, the **woven** web or the **knit** web under the ***pressure*** of roll 58 against the roll 57.

3. Claims 71-79, 81-83, 85-90, and 92-115 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the *enablement* requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The limitation "the polymer forming the polymeric regions does not extend *through* the substrate" (independent claims 71, 83, 94, 109-115), wherein the substrate is **porous** material, a **fibrous** material, a **woven** web or a **knit** web, was not described in the specification in such a way as to enable one skilled in the art to prevent the melted polymer to go *through* the **fibrous** material, the **woven** web or the **knit** web under the ***pressure*** of roll 58 against the roll 57.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined

application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Rejection of claims 71-79, 81-83, 85-90, 92-115 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 10-21, 285 of U.S. Patent No. US 6,503,855 has been withdrawn due to filing of the terminal disclaimer.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 109, 111, and 114-115 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wessels et al (US 5,669,120) for the reasons of record set forth in paragraph 7 of the Office Action mailed on 12/12/2007 because amendment addressed only formal matters.

9. Claims 71-79, 81-83, 86-90, 92-106, and 108-115 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wessels et al in view of Allen et al for the reasons of record set forth in paragraph 8 of the Office Action mailed on 12/12/2007.

10. Claims 71-79, 81-83, 86-90, 92-106, and 108-115 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wessels et al in view of Allen et al and Provost et al (US 5606781) for the reasons of record set forth in paragraph 9 of the Office Action mailed on 12/12/2007.

11. Claims 85, 107 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wessels et al in view of Allen et al/Wessels et al in view of Allen et al and Provost et al/, further in view of Murasaki (US 5,643,651) for the reasons of record set forth in paragraph 9 of the Office Action mailed on 4/13/2006.

Response to Arguments

10. Applicants' arguments filed April 14, 2008 have been fully considered but they are not persuasive.

(A) Rejection of claims 109, 111, 114, and 115 over Wessels et al

Applicants argue that Wessels et al. does not disclose or suggest a substrate in the form of a "film" before the polymer forming the hooks is forced through the pores of the substrate S as asserted by the Examiner. Rather, the polymer layer 4a is formed at the same time as the hooks 4b as described in Wessels et al. at Column 7. As a result, Wessels et el. do not teach a polymer

"film" that is separate from the hook elements 4b. The polymer used to form the hook elements 4b is that same polymer used to form the substrata 4a.

The Examiner respectfully disagrees with this argument. First of all, rejected claims also do not recite a polymer "film" that is *separate* from the hook elements 4b". Second, Wessels et al. does show at Fig. 5 forming a substrate in the form of a "film" 4 *before* forming the hooks. Third, the polymer forming the polymeric regions does not extend *through* the substrate for at least the reason that only ***upper* portion** in only discrete regions of the formed substrate film 4 is used for forming hooks. Forth, following applicants logic, in claimed invention the molten polymer applied to a **fibrous** (Claim 75), **porous** (Claim 76), **woven** (Claim 77), **knit** (Claim 79) substrate and *pressed* (See Applicants Figs. 5-6 would extend *through* the substrate. Applicants' specification teaches also that in case when the web 10 itself contains loop structures, as claimed in claims 73, woven and non-woven fibers are used (See Published Application, P23).

(B) Rejection of claims 71-79, 81-83, 86-90, 92-106, and 108-115 over Wessels et al in view of Allen

Applicants argue that the asserted obviousness rejection of claims 71-79, 81-83, 86-90, 92-106, and 108-118 does not address claimed feature in any meaningful manner in connection with any of the obviousness rejections identified above. Instead the Examiner relies on the teachings of column 10, lines 53-60 of Wessels et al. as support for an assertion that Wessels et al. discloses or suggests changing the shape and/or spacing of the polymer regions containing the hooks. Applicants respectfully disagree and have reproduced the cited portion of Wessels et al.

The argument is unconvincing because Applicants did not address in any meaningful manner Wessels et al **combined** with Allen. It is well settled that one cannot show nonobviousness by attacking references *individually* where the rejections are based on **combinations** of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

(C) Rejection of claims 71-79, 81-83, 86-90, 92-106, and 108-115 over Wessels et al in view of Allen and Provost

Applicants submit that Provost et al. are cited to provide evidence that, e.g., hooks can be integrally molded with a base, can be co-extruded with a base, or can be provided on a thin base and laminated to a different sheet to form a substrate (Office Action delivered 12 December 2007, page 6, line 16 to page 7, line 2. Applicants submit, however, that Provost et al fail to provide elements missing from the combination of Wessels et al. and Allen et al. For example, Provost et al. fail to provide a plurality of discrete polymeric regions fused (or attached, claims 114 and 115) to the first major surface of the substrate, wherein each discrete polymeric region is entirely bordered or surrounded by the first major side of the substrate (claims 71, 83, 94, 109, and 111- 115) nor do Provost et al. teach or suggest an elastic substrate (claims 83 and 110).

The argument is unconvincing because by Applicants own admission, Provost et al. is a secondary reference which is cited to provide an **evidence** that hooks can be integrally molded with a base, can be co-extruded with a base, or can be provided on a thin base and laminated to a different sheet to form a substrate. Note that all claimed limitations were shown to be obvious over Wessels et al *combined* with Allen, which Applicants failed to discuss above in (B).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elena Tsoy Lightfoot whose telephone number is 571-272-1429. The examiner can normally be reached on Monday-Friday, 9:00AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Elena Tsoy Lightfoot, Ph.D.
Primary Examiner
Art Unit 1792

October 4, 2008

/Elena Tsoy Lightfoot/